

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:	Michael S. Beck Kevin L. Conrad	Group Art Unit:	3661
Serial No.:	10/784,341	Examiner:	Chong H. Nguyen
Filed:	February 23, 2004	Atty. Dkt.:	2063.007400
For:	System And Method For Dynamically Controlling An Attitude Of An Articulated Vehicle	Client Docket:	VS-00647

**PETITION UNDER 37 CFR 1.181(A)(1)
TO INVOKE THE SUPERVISORY AUTHORITY
OF THE COMMISSIONER**

Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicant hereby petitions the Commissioner under 37 CFR 1.181(a)(1) and MPEP 1002.02(c)(3)(c) to invoke his supervisory authority with respect to an improperly imposed and improperly implemented restriction requirement. It is believed a fee of \$130 is due for the petition and the Commissioner is authorized to deduct or credit any additional fees from or to Williams, Morgan & Amerson, P.C. Deposit Account No. 50-0786/2086.007400.

STATEMENT OF FACTS

1. The present application was filed on February 23, 2004.
2. The application as filed included claims 1-53.
3. The Office mailed the first Office Action on May 4, 2007 (the "first Office Action").

4. The first Office Action (1) examined each and every one of claims 1-53 on the merits, and (2) required restriction among three groups of claims. (first Office Action, “Detailed Action”, pp. 2-4, ¶¶3-6)
5. With respect to the examination on the merits, the first Office Action rejected claims 1, 2, 5, 38 and 46 as indefinite under 35 U.S.C. §112, ¶2 as indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. (*Id.*, p. 2, ¶3)
6. With respect to the restriction requirement, the Office grouped the claims as follows:
 - Group I—claims 1-19, directed to a method for controlling the stability of a vehicle;
 - Group II—claims 20-45 directed to a method and apparatus for controlling a vehicle’s stability; and
 - Group III—claims 46-53 directed to a vehicle having a sensors and a controller to control a vehicle’s stability.(*Id.*, pp. 2-3, ¶6)
7. Thus, each of the “inventions” identified in the restriction requirement included a claim that was examined on the merits and rejected. (*Id.*, pp. 2-4, ¶¶2-6)
8. Applicants responded to the first Office Action in writing on August 6, 2007 (the “first Response”).
9. The first response elected the Group I claims and timely traversed restriction requirement. (first Response, pp. 14-19)
10. Applicants also traversed the rejections. (first Response, pp. 10-14)
11. The Office mailed another Office Action (the “second Office Action”) on October 24, 2007.
12. In the second Office Action, the Office (1) again examined all the claims in the case on the merits, and (2) re-imposed the restriction requirement. (second Office Action, “Detailed Action”, pp. 2-5, ¶¶3-8)
13. With respect to the examination on the merits, the Office maintained some of the indefiniteness rejections from the first Office Action rejected claims 1, 14, 20, 38, and 46 as indefinite under 35 U.S.C. §112, ¶2. (*Id.*, pp. 2-4, ¶¶3-5)

14. With respect to the restriction requirement, the Office rejected Applicants' traversal because the claims are broad (*Id.*, p. 2, ¶3) and reiterated the restriction (*Id.*, pp. 4-5, ¶8).
15. The Office did not, however, make the restriction requirement final" (*Id.*, pp. 2, 4-5, ¶¶3, 8)
16. The second Office Action was a non-final Office Action. (*Id.*, "Office Action Summary")
17. Applicants responded to the second Office Action in writing on December 17, 2007 (the "second Response").
18. The second response again elected the Group I claims and timely traversed restriction requirement. (second Response, p. 3-6)
19. Applicants filed a Notice of Appeal from the rejections in the second Office Action on December 17, 2007, concurrently with the second Response.
20. Applicants filed an Appeal Brief on December 17, 2007, concurrently with the second Response and the Notice of Appeal.
21. The Office mailed yet another Office Action on March 25, 2008 (the "third Office Action").
22. The third Office Action appears to have been a clerical error on the part of the Office, in that it comprised an "Office Action Summary" and a copy of the first Office Action.
23. The Office therefore mailed still another Office Action on March 31, 2008 (the "fourth Office Action").
24. The fourth Office Action again examined claims 1-19 on the merits and rejected each of them on a variety of grounds. (fourth Office Action, "Detailed Action", pp. 3-11, ¶¶4-8)
25. The fourth Office Action did not address claims 20-53 in any way other than to (1) indicate that they were pending in the case (*Id.*, "Office Action Summary", "Detailed Action, p. 2, ¶2), and (2) were subject to restriction (*Id.*, "Office Action Summary").
26. The fourth Office Action did not make the restriction requirement "final". (*Id.*, "Detailed Action", p. 2, ¶2)

27. The fourth Office Action did not reiterate the restriction requirement. (*Id.*)
28. The fourth Office Action did not withdraw claims 20-53 from consideration. (*Id.*, “Office Action Summary”, “Detailed Action”, p. 2, ¶2)
29. Applicants responded to the fourth Office Action in writing on July 31, 2008 (the “third Response”).
30. The third response maintained Applicants’ traverse of the restriction requirement. (third Response, p. 11)
31. Applicants also traversed the rejections. (third Response, pp. 12-15.)
32. The Office mailed still another Office Action (the “fifth Office Action”) on December 2, 2008.
33. The fifth Office Action was made “final” and closed prosecution on the merits. (fifth Office Action, “Office Action Summary”, “Detailed Action”, p. 10, ¶9)
34. The Office finally made the restriction requirement final. (*Id.*, “Detailed Action”, p. 2, ¶2)
35. The fifth Office Action again examined claims 1-19 on the merits and rejected each of them on a variety of grounds. (*Id.*, pp. 2-10, ¶¶4-8)
36. The fifth Office Action still did not address claims 20-53 in any way other than to (1) indicate that they were pending in the case (*Id.*, “Office Action Summary”, “Detailed Action”, p. 2, ¶2), and (2) were subject to restriction (*Id.*, “Office Action Summary”).
37. The fifth Office Action still did not withdraw claims 20-53 from consideration. (*Id.*, “Office Action Summary”, “Detailed Action”, p. 2, ¶2)
38. Applicants responded to the fifth Office Action in writing on February 2, 2009 (the “fourth Response”).
39. The fourth Response maintained Applicants’ traverse of the restriction requirement. (fourth Response, pp. 2-3)
40. Applicants also traversed the rejections. (fourth Response, pp. 3-4)
41. The Office mailed an Advisory Action on February 26, 2009 (the “Advisory Action”).
42. The Advisory Action maintained the rejections of claims 1-19 made final for the first time in the fifth Office Action. (Advisory Action, “Office Action Summary”)

43. The Advisory Action also did not address claims 20-53 in any way other than to (1) indicate that they were pending in the case, and (2) were subject to restriction. (*Id.*)
44. The Advisory Action still did not withdraw claims 20-53 from consideration. (*Id.*)
45. Applicants file concurrently herewith a Notice of Appeal.
46. Applicants file concurrently herewith a Petition for Pre-Trial Review.

ARGUMENT

I. STATUS OF THE CLAIMS

Claims 1-53 are pending in the case. The Office rejected claims 1-19 as follows:

- claims 1-4, 9-10, 14-15, and 17-18 as anticipated under 35 U.S.C. §102(e) by U.S. Letters Patent 6,010,139 (“Heyring et al.”);
- claim 5 as obvious under 35 U.S.C. §103(a) over Heyring et al. in combination with U.S. Publication No. 2003/0001734 (“Schofield”);¹
- claims 6 and 15 as obvious under 35 U.S.C. §103(a) over Heyring et al. in combination with U.S. Patent No. 6,267,196 (“Wilcox”);
- claims 7-9, 13, 16 and 19 as obvious under 35 U.S.C. §103(a) over Heyring et al. in combination with U.S. Patent No. 4,313,511 (“Soo Hoo”); and
- claims 11-12 as obvious under 35 U.S.C. §103(a) over Heyring et al. in combination with U.S. Patent No. 4,243,278 (“Horan”).

The current status of claims 20-53 is ambiguous. The Office has not officially withdrawn these claims, but has not examined them since the second Office Action. For purposes of prosecution, Applicants have considered those claims to have been implicitly withdrawn. Each of the rejections is currently on appeal.

¹ Applicants do not concede the status of Schofield as “prior art”. Schofield does not actually qualify as prior art under any provision of 35 U.S.C. §102. The Office may nevertheless cite Schofield under the legal fiction that it evidences what was “known by others” under 35 U.S.C. §102(a) on the assumption that Applicants’ date of invention is their date of filing. Applicants reserve the right to “swear behind” Schofield at a future date should they choose to do so. *See* M.P.E.P. §2132.91.

II. THE RESTRICTION REQUIREMENT & APPLICANTS' ELECTION, WITH TRAVERSE

For purposes of restriction, the Office grouped the claims as follows:

- Group I—claims 1-19, directed to a method for controlling the stability of a vehicle;
- Group II—claims 20-45 directed to a method and apparatus for controlling a vehicle's stability; and
- Group III—claims 46-53 directed to a vehicle having a sensors and a controller to control a vehicle's stability.

In response to the restriction requirement, elected with traverse, to prosecute claims 1-19, *i.e.*, the Group I claims. The election was made both times the Office required restriction. Applicants traversed the restriction at the time it was made, and in every communication with the Office since then.

III. THE RESTRICTION REQUIREMENT WAS IMPOSED AND IMPLEMENTED IN ERROR

In the first Office Action, the Office examined all the claims in the case while at the same time imposing a restriction requirement. The Office did the same thing in the second Office Action—examining all claims and repeating the exact same restriction without addressing Applicants' traversal. After the appeal, the Office no longer examined the claims subject to restriction, but neither expressly withdrew them nor made the restriction final. Indeed, the Office did not make the restriction requirement final until it closed prosecution on the merits in what was essentially the fourth Office Action—the second Office Action after the appeal. There are a number of errors in the Office's imposition and implementation of the restriction requirement, which Applicants address below.

A. THE RESTRICTION REQUIREMENT WAS IMPROPERLY IMPOSED

Applicants traverse the restriction on three grounds, namely:

- the restriction flouts the Office policy of compact prosecution;

- the restriction requirement has not been properly made;
- there is no serious burden absent restriction; and
- the claims are improperly grouped.

Applicants address each of these grounds in turn.

1. The Restriction Flouts the Office Policy of Compact Prosecution

The present restriction flouts the Office policy of compact prosecution. Every claim subject to restriction:

- is an originally filed claim (Fact #2);
- was twice examined on the merits (Facts #4, #12) prior to the restriction being made final (Fact # 34); and
- was twice rejected (Facts #5, #13) and once appealed (Facts #19, #20) prior to the restriction being made final (Fact # 34).

Indeed, the present case presents an anomaly in which claims 20, 38, 46, are now apparently withdrawn from consideration after having been examined on the merits and rejected and the rejections appealed.

While it is true that the timing of restriction is fairly flexible, "...The examiner should make a proper requirement as early as possible in the prosecution, in the first action if possible, otherwise, as soon as the need for a proper requirement develops." M.P.E.P. §811. Excluding the apparently erroneous third Office Action, the present case proceeded through four Office Actions and an appeal before being made "final". During that course of prosecution, three of the claims now apparently withdrawn were twice rejected and the rejections appealed. Accordingly, the present restriction clearly has not been made "as early as possible in the prosecution."

2. The Restriction has NOT Been Properly Made

According to the M.P.E.P.:

There are two criteria for a proper requirement for restriction between patentably distinct inventions:

(A) The inventions must be independent (see MPEP § 802.01, § 806.06, § 808.01) or distinct as claimed (see MPEP § 806.05 - § 806.05(j)); and

(B) There would be a serious burden on the examiner if restriction is not required (see MPEP § 803.02, § 808, and § 808.02).

M.P.E.P. §803 (emphasis added).

The Office has failed to properly allege that the absence of restriction would impose a “serious burden”. “For purposes of the initial requirement, a serious burden on the examiner may be *prima facie* shown by appropriate explanation of separate classification, or separate status in the art, or a different field of search as defined in MPEP § 808.02.” *Id.* The Office does allege separate classifications, but they are based on an improper characterization of the claims, as is discussed below regarding the improper grouping of the claims. It is therefore apparent that the requirement is improper on its face. *Id.*

However, regardless of whatever the Office may have *said*, the Office’s assertion of “additional undue burden” is repudiated by the Office’s own actions on the record. The Office twice proposed restriction earlier in the prosecution (Facts #4, #12). Neither restriction requirement was made final (Facts #42), and the Office proceeded to examine the entire case on both occasions (Facts #5, #13) without regard to the proposed restriction. Indeed, every claim in the case has already been twice examined (Facts #5, #13) and the resulting rejections appealed (Fact #19, 20). Whatever *pro forma* reasons the Office might be able to propose through use of form language, the Office’s actions clearly refute them.

3. There is No “Serious Burden” Absent Restriction

According to Office policy regarding restriction, “[i]f the search and examination of all the claims in an application can be made without serious burden, the examiner must examine them on the merits, even though they include claims to independent or distinct inventions.” M.P.E.P. §803. As is established below, all the independent claims are linked, and so must be examined together. M.P.E.P. §809. If the linking claims are

allowed, the rest of their Groups must be rejoined for examination. *Id.* There are other numerous linking claims among the dependent claims, as well. By the time all the linking claims are all examined with the elected claims, there will be little examination left. There consequently would be no “serious burden” caused by a lack of restriction if Office policy is correctly followed given that most of the burden will be borne even if the restriction is imposed.

Applicants respectfully submit that ***all three groups are linked***. In Table A, set forth immediately below, Group I, represented by claim 1, is linked to Group II, represented by claim 20. The difference between claim 1 and claim 20 is that claim 1 is generic to claim 20, claim 20 specifying that (1) the one “dynamic property” of claim 1 is, in claim 20, the load on the wheel assemblies, and (2) the “manipulation” of claim 1 affects the vehicle’s center of gravity in claim 20. Table B, also set forth below, establishes that Group II, represented by claim 38, and Group III, represented by claim 46, are also linked.

TABLE A. Groups I and II are Linked

Group I	Group II
<p>1. A method of controlling stability of a vehicle having an articulated suspension, comprising:</p> <p>determining at least one dynamic property of the vehicle; and</p> <p>manipulating the articulated suspension based on the at least one dynamic property to affect the stability of the vehicle.</p>	<p>20. A method of controlling stability of a vehicle having an articulated suspension, comprising:</p> <p>determining a load on each of a plurality of wheel assemblies of the articulated suspension; and</p> <p>manipulating at least one component of the vehicle to affect a center of gravity of the vehicle or the vehicle’s stability limits.</p>

TABLE B. Groups II and III are Linked

Group II	Group III
<p>38. A system for controlling stability of a vehicle having an articulated suspension, comprising:</p> <p><i>a plurality of sensors for sensing a state of the vehicle; and</i></p> <p><i>a controller coupled with the plurality of sensors and adapted to articulate at least one component of the vehicle to affect the vehicle's center of gravity or the vehicle's stability limits.</i></p>	<p>46. A vehicle, comprising:</p> <p>a chassis;</p> <p>at least one component articulable with respect to the chassis;</p> <p><i>a plurality of sensors for sensing a state of the vehicle; and</i></p> <p><i>a controller coupled with the plurality of sensors and adapted to articulate the at least one articulable component to affect the vehicle's center of gravity or the vehicle's stability limits.</i></p>

Accordingly, claim 20 of Group II must be examined with the elected Group I claims. If allowed, then Group II must be rejoined for examination. M.P.E.P. §809. At that point, claim 40 of Group III must be examined. *Id.* If allowed, then Group III must be rejoined for examination. *Id.* Thus, the restriction is improvident since most of the burden in examination will borne anyway if Office policy is correctly followed. M.P.E.P. §803.

4. The Claims are Improperly Grouped

Applicants challenge the grouping of the claims in the event that restriction is deemed proper. More particularly, Applicants respectfully submit that claims 38-45, in Group II, should more properly grouped with claims 46-53 of Group III. Claims 20, 38, and 46 are set out side-by-side below in Table C for the convenience of the Office to facilitate the review. The emphasis shows the common limitations among the claims. As

one can see, there are no common limitations between claims 20 and 38, but there are substantial common limitations between claims 38 and 46.

TABLE C. Groups II and III Should Be Merged

Group II	Group II	Group III
<p>20. (Currently Amended) <i>A method of controlling stability of a vehicle having an articulated suspension</i>, comprising:</p> <p>determining a load on each of a plurality of wheel assemblies of the articulated suspension; and</p> <p>manipulating at least one component of the vehicle to affect a center of gravity of the vehicle or the vehicle's stability limits.</p>	<p>38. (Currently Amended) <i>A system for controlling stability of a vehicle having an articulated suspension</i>, comprising:</p> <p><i>a plurality of sensors for sensing a state of the vehicle; and</i></p> <p><i>a controller coupled with the plurality of sensors and adapted to articulate at least one component of the vehicle to affect the vehicle's center of gravity or the vehicle's stability limits.</i></p>	<p>46. (Currently Amended) A vehicle, comprising:</p> <p>a chassis;</p> <p>at least one component articulable with respect to the chassis;</p> <p><i>a plurality of sensors for sensing a state of the vehicle; and</i></p> <p><i>a controller coupled with the plurality of sensors and adapted to articulate the at least one articulable component to affect the vehicle's center of gravity or the vehicle's stability limits.</i></p>

Applicants also challenge the groupings in that Groups I and II should be merged into the same group. Claim 1, or Group I, and claim 20, of Group II, are set together side by side below in Table D. The difference between claim 1 and claim 20 is that claim 1 is generic to claim 20, claim 20 specifying that (1) the one “dynamic property” of claim 1 is, in claim 20, the load on the wheel assemblies, and (2) the “manipulation” of claim 1 affects the vehicle’s center of gravity in claim 20. Accordingly, Applicants respectfully submit that Groups I and II should be merged.

TABLE D. Groups I and II Should Be Merged

Group I	Group II
<p>1. (Original) A method of controlling stability of a vehicle having an articulated suspension, comprising:</p> <p>determining at least one dynamic property of the vehicle; and</p> <p>manipulating the articulated suspension based on the at least one dynamic property to affect the stability of the vehicle.</p>	<p>20. (Currently Amended) A method of controlling stability of a vehicle having an articulated suspension, comprising:</p> <p>determining a load on each of a plurality of wheel assemblies of the articulated suspension; and</p> <p>manipulating at least one component of the vehicle to affect a center of gravity of the vehicle or the vehicle's stability limits.</p>

Thus, even if the Office deems restriction appropriate in light of the facts and arguments set forth herein, the claims should be regrouped. In particular, Groups I and II should be merged and Groups II and III should be merged. Note that this position is consistent with Applicants' position on the propriety of the restriction as whole since it would effectively moot the restriction requirement if both mergers occur.

5. Conclusion on Implementation

The Office therefore committed at least four errors in the imposition of the restriction requirement. The Office unduly delayed in its imposition until the non-elected claims had been twice examined on the merits and the rejections appealed once. This undue delay furthermore repudiated the Office's own position that there would be an undue burden absent restriction. Even were that not true, the groups are so thoroughly linked that, if properly examined in accordance with Office practice, all claims will wind up in the case such that there would be no difference in burden with or without restriction. Finally, the Office has grouped the claims improperly.

**B. THE RESTRICTION REQUIREMENT
WAS IMPROPERLY IMPLEMENTED**

Office policy clearly states that "...linking claims must be examined with, and thus are considered part of, the invention elected." M.P.E.P. §809. Applicants respectfully submit that *all three groups are linked*. The links are established above in Section III A 3 above, and Applicants hereby incorporate and adopt that argument herein in support of this position.

However, since the appeal, the Office apparently is examining only the elected Group I claims and none of the linking claims. (Facts #24-#25, #35-#36) The status of the Group II and Group III claims since the appeal is somewhat ambiguous as noted above. There nevertheless is no indication that any of claims 20-53 have been examined since prosecution was re-opened after the appeal. (Facts #25, #36) Applicants accordingly assume that there has been no examination of these claims. Thus, the Office has erred in not examining the claims linking Group I to Group II. M.P.E.P. §809.

IV. CONCLUDING REMARKS

Wherefore, Applicants pray that (1) the restriction requirement be lifted and all claims be rejoined for examination, or (2) alternatively, the claims be properly grouped as proposed herein, or (3) again alternatively, the Examiner be instructed to examine the claims linking the groups.

The Examiner is invited to contact the undersigned attorney at (713) 934-4053 with any questions, comments or suggestions relating to the referenced patent application.

Respectfully submitted,

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